

REMARKS**Response to Objections**

As noted above and regarding paragraph 5 of the Office Action, Applicants' have reviewed the abstract under Abstract of Disclosure, paragraph 0057 of the application as filed, and find the word count to be 145 words. Since this is within the 150 word limit, Applicants request that the Office withdraw the objection to the abstract as filed.

Response to Claim Rejections Under 35 U.S.C. § 101

Regarding paragraph 4 and 8 of the Office Action concerning the rejection of claims 1 – 38 as directed non-statutory subject matter because they do not produce any concrete and tangible result, applicants have amended claims 1, 15, 24 and 31 to remove the conditional limitation from claims 1, 15, 24 and 31, thereby limiting the scope of claims 1–38 and making them statutory. The first element of claims 1, 15 and 31 has been amended to include the step of / means for “comparing a law...with a...checklist for determining that a change is required...;” The second element of claims 1, 15 and 31 has been amended to include the step of / means for “preparing a rule documentation report based on the required change and derived from the law and...;” The second element of claim 24 has been amended to include “a compliance subjects checklist...to identify that a change...is required;” Note that the production of a regulatory compliance results file indicating subject areas in compliance and subject areas of non-compliance with the law are useful, concrete and tangible results useful to financial institutions for verifying compliance with relevant legal requirements. Applicants request withdrawal of these rejections of claims 1-38 based on the claim amendments and that they are now be considered to be statutory subject matter under 35 U.S.C. § 101.

Regarding paragraph 9 of the Office Action, the Office has rejected claims 24-30 as directed non-statutory subject matter because they are directed to descriptive material and the limitations of the claims recite nonfunctional descriptive material. Applicants have amended claim 24 in order direct the claims 24-30 to statutory subject matter by providing functional and structural limitations to claim 24. Applicants request withdrawal of these rejections of claims 24-30 based on the claim amendments and that they are now be considered to be statutory subject matter under 35 U.S.C. § 101.

Response to Claim Rejections Under 35 U.S.C. § 102(b)

Regarding paragraphs 10-15 of the Office Action, the Office has rejected claims 1-6 and 8-38 under 35 U.S.C. § 102(b) as being anticipated U.S. Patent No. 6,341,287 by Sziklai et al. The rejections are based on an assumed alternative embodiment where a change is not required, particularly with regard to independent claims 1, 15, 24 and 31. Based on this assumed embodiment, the Office posits that the limitation of “preparing a rule documentation report...” as well as “preparing at least one rule change...”, “creating at least one new computer-encoded compliance rule...” and “assessing regulatory compliance...” are optional, and are therefore not required. The Office then relies on the Sziklai reference to assert anticipation based on only the first limitation of applicants’ claim, namely “comparing a law imposing requirements...”

As a result of the 35 U.S.C. § 101 rejections discussed above, applicants have amended independent claims 1, 15, 24 and 31 to eliminate the non-statutory alternative relied on by the Office to support a rejection under 35 U.S.C. § 102(b). Therefore, the limitations in applicants’ independent claims always include all of the limitations found in the independent claims, including the limitations of “comparing a law imposing requirements...”, “preparing a rule

documentation report...”, “preparing at least one rule change...”, “creating at least one new computer-encoded compliance rule...” and “assessing regulatory compliance...”.

Anticipation under 35 U.S.C. § 102 requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. In deciding the issue of anticipation, the trier of fact must identify the elements of the claims, determine their meaning in light of the specification and prosecution history, and identify corresponding elements disclosed in the allegedly anticipating reference. *See Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452. The first limitation of applicants’ independent claims recites “comparing a law imposing requirements for a regulated transaction with a compliance subjects checklist for determining that a change is required in the regulatory compliance rules repository...” The reference of Sziklai teaches “(1) a change management layer 11 that includes one or more change agents that ‘cruise the web’ and identify and bring to the user’s attention relevant regulatory and non-regulatory changes found on the web that may affect a user’s business;...” There is no disclosure in Sziklai of how these change agents determine that a change is required. There is no disclosure of comparing laws with a compliance subjects checklist. The suggestion by the Office that the “worklists” disclosed in Sziklai is equivalent to applicants’ compliance subjects checklist is not valid, since the “worklists” in Sziklai is a feature of the user interface in a third metadata layer (see column 9, lines 35-40 describing layer 3), far removed from the first change management layer 1. There is no teaching in Sziklai of applicants’ first independent claim limitation of “comparing a law imposing requirements for a regulated transaction with a compliance subjects checklist for determining that a change is required in the regulatory compliance rules repository...” Furthermore, there is no disclosure in Sziklai of applicants additional independent claim

limitations of “preparing a rule documentation report...”, “preparing at least one rule change...”, “creating at least one new computer-encoded compliance rule...” and “assessing regulatory compliance...” Since all the elements of applicants’ independent claims 1, 15, 24 and 31 are not disclosed in Sziklai, applicants request withdrawal of the rejections of independent claims 1, 15, 24 and 31 under 35 U.S.C § 102(b), as well as all claims depending on these independent claims, since none of the elements of applicants’ dependent claims are found in Sziklai.

Response to Claim Rejections Under 35 U.S.C. § 103(a)

Regarding paragraphs 16-20 of the Office Action, the Office has rejected claim 7 under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 6,341,287 by Sziklai et al as applied to claims 1-6 and 8-38 above and further in view of U.S. Patent Publication 2002/0143562 by Lawrence. Concerning paragraph 17 of the Office Action, U.S. Patent Application No. 10/710,866 was, at the time the invention of U.S. Patent Application No. 10/710,866 was made, owned or subject to an obligation of assignment to the same entity, Mavent, Inc., as evidenced by the inventors’ assignments recorded in the U.S. Patent Office at reel 015877, frame 0312.

Paragraph 18-20 of the Office Action asserts that Sziklai describes all the required limitations of applicants claimed invention except for the limitation of dependent claim 7, which is described by Lawrence. As discussed above, it has been shown that applicants’ claims 1-6 and 8-38 are not disclosed in Sziklai. And more particularly, since dependent claim 7 depends on independent claim 1, which has been shown above to not being anticipated by Sziklai, claim 7 is not obvious over Sziklai in view of Lawrence. Applicants request withdrawal of the rejection of claim 7 under 35 U.S.C. § 103(a).

SUMMARY

It has been shown above that the rejections of claims 1-38 under 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a) are not supported by the references cited by the Office. Reconsideration and further examination are requested.

Applicants have made a diligent effort to place the claims in condition for allowance. However, should there remain unresolved issues that require adverse action, it is requested that the Examiner telephone Douglas D. Russell, Applicants' Attorney at 512-338-4601 so that such issues may be resolved as expeditiously as possible.

For these reasons, and in view of the above amendments, this application is now considered to be in condition for allowance and such action is earnestly solicited.

Respectfully Submitted,

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Date

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